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Paper No.

Letter Withdrawing a Notice of Non-Compliant Amendment

The Notice of Non-Compliant Amendment mailed on 5-31-05 was sent in error, and is hereby withdrawn. The application is being forwarded to the examiner for appropriate action. (Note: this letter does not apply to any Notice of Non-Compliant Amendment where the amendment was a reply to a final Office action.)

C. Queen
Legal Instruments Examiner (LIE)

571-272-1041
Telephone No.

IN THE US PATENT OFFICE

EXAMINER -BEISNER

GROUP - 1744

SN -09/927049

FILED - 8/9/01

BY - TAnaami

I hereby certify that the correspondence upon which this notice is placed is being deposited with the US Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, Box 1450 Alexandria, VA 22313, or to US Trademark Office, 2900 Crystal Drive, Arlington, VA 22202, on the date set forth below. MOONRAY KOJIMA, ATTORNEY

Date 6/17/05 (signed)

SIRS:

This is in response to the "notice of non-compliant amendment" mailed on 6//605.

The "Legal Instruments Examiner" Crystal Queen, alleged "Each section of an amdt must start on a page by itself, put the remarks on a page by itself after the claims".

Our response dated 5/26/05 DOES COMPLY IN FACT WITH THE RULES. See our appendix A-E for a listing of the amendment to claims. As your rules state "Begin each section of an amendment document on a separate sheet: Each section of an amendment document ... Claim Amendment... must begin on a separate sheet.. This is the case with our amendment to claims, appendix A-E. THERE ARE NO AMENDMENT TO SPECIFICATION OR DRAWINGS.

Also, in the claims listing, See the "Exammple of listing of claims" which model has been followed.

The discussion of the claims is separate .. see REMARKS. THere is nothing in the Rules that state that the discussion must be after listing of the amendments to the claims. Thus all rules are followed and entry is respectfully solicited.

respectfully

M. KOJIMA

MOONRAY KOJIMA
BOX 627
WILLIASMTOWN, MA 01267
Tel (413)458-2880

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BY - Tanaami

AMENDMENT

SIRS:

Only Summary See Claims Listings After A-E

Responsive to the OA of 4/19/05, please amend as follows:

Claim 1 - 67, previously cancelled, as shown in the Appendix.

Claim 73, and claim 81, cancel without prejudice, as shown in Appendix.

Claims 70,74,78, 82, amend as shown in the Appendix.

REMARKS

Spark Discussion

Claims 68-72,74-80, 82 and 83are in the application. Claim 73, and claim 81have been cancelled to expedite prosecution. Claims 70,74,78,and 82 have been amended to remove the reference to both electrodes being protrusions and transparent, and thus avoid the Section 112 objection. Claims 68,69,72,76,77 and 80 were allowed.

There being no further issues, allowance is respectfully solicited of all the claims now in the application, namely, claims 68-72, 74-80, 82 and 83.

Respectfully

M. KOJIMA

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26 May 05

Claims 1-67 (cancelled)

68. (original) A measuring apparatus for measuring genetic sequence of electrically charged biopolymers by hybridization, said apparatus comprising:

a container that contains known biopolymer segments fixed onto an inner wall of said container and unknown biopolymer segments existing in a solution contained within said container, which are to be hybridized, said container being removable from said measuring apparatus; and

one or more electrodes disposed to be adjacent to said container for applying an electric field to said container, said one or more electrodes being electrically insulated from said container, and further being provided with protrusions formed at spatial positions corresponding to sites whereat gather a plurality of types of biopolymer segments within said container, wherein

conductive members are formed at spatial positions corresponding to said sites.

69 (original) The apparatus of claim 68, wherein said biopolymer segments are DNA, RNA, PNA or electrically charged proteins.

70.(currently amended) A measuring apparatus for measuring genetic sequence of electrically charged bipolymers by hybridization, said apparatus comprising:

a container that contains known biopolymer segments fixed onto an inner wall of said container and unknown biopolymer segs

ments existing in a solution contained within siad container, which are to be hybridized, said container being removable from said measuring apparatus; and

one or more electrodes disposed to be adjacent to said container for applying an electric field to said container, said one or more electrodes being electrically insulated from said container, and further being provided with protrusions formed at spatial positions corresponding to sites whereat gather a plurality of types of biopolymer segments within said container, wherein

said container is made of a film, and said one or more electrodes are in mechanical contact with said container ~~and are made of transparent film~~ .

71. (original) The apparatus of claim 70, wherein said biopolymer segments are DNA, RNA, PNA or electrically charged proteins.

72. (original) The apparatus of claim 68, wherein said container is made of a film.

73. (cancelled)

74.(currently amended) A measuring apparatus for measuring genetic sequence of electrically charged biopolymer by hybridization, said apparatus comprising:

[a] <u>an insulating</u> container that contains known biopolymer segments fixed onto an inner wall of said container and unknown biopolymer segments existing in a solution contained within said container, which are to be hybridized, said container being removable from said measuring apparatus; and

one or more electrodes disposed to be adjacent to said con-

tainer for applying an electric field to said container, said one or more electrodes being electrically insulated from said container, and further being ~~provided with protrusions~~ formed at least at spatial positions corresponding to sites whereat gather a plurality of types of biopolymer segments within said container, wherein said one or more electrodes are transparent electrodes.

75.(original) The apparatus of claim 74, wherein said one or more electrodes are made of ITO film.

76. (original) A measuring apparatus for measuring genetic sequence of electrically charged biopolymers by hybridization, said apparatus comprising:

a container that contains known biopolymer segments fixed onto an inner wall of said container and unknown biopolymer segments existing in a solution contained within said container which are to be hybridized, said container being removable from said measuring apparatus;

one or more electrodes disposed to be adjacent to said container for applying an electrical field to said container, said one or more electrodes being electrically insulated from said container; and

means for altering direction of said electric field so that wrongly hybridized segment pairs are separated; wherein

said one or more electrodes are provided with protrusions formed at spatial positions corresponding to sites whereat gather a plurality of types of biopolymer segments within said container; wherein conductive members are formed at spatial posi-

tions corresponding to said sites.

77.(original) The apparatus of claim 76, wherein said biopolymer segments are DNA,RNA, PNA or electrically charged proteins.

78.(currently amended) A measuring apparatus for measuring genetic sequence of electrically charged biopolymers by hybridization, said apparatus comprising:

[a] an insulating container that contains known biopolymer segments fixed onto an inner wall of said container and unknown biopolymer segmnets existing in a solution contained within said container which are to be hybridized, said container being removable from said measuring apparatus;

one or more electrodes disposed to be adjacent to said container for applying an electrical field to said container, said one or more electrodes being electrically insulated from said container; and

means for altering direction of said electrical field so that wrongly hybridized segment pairs are separated; wherein

said one or more electrodes are ~~provided with protrusions~~ formed at least at spatial positions corresponding to sites whereat gather a plurality of types of biopolymer segments within said container, wherein

said container is a film; wherein

conductive members are formed at spatial positions corresponding to said sites; and wherein

said one or more electrodes are in mechanical contact with said container and are made of transparent film.

79.(original) The apparatus of claim 78, wherein said bio-

polymer segments are DNA, RNA, PNA or electrically charged proteins.

80.(original) The apparatus of claim 76, wherein said container is made of a film.

81. (cancelled)

82.(currently amended) A measuring apparatus for measuring genetic sequence of electrically charged biopolymers by hybridization, said apparatus comprising:

a container that contains known bipolymer segments fixed onto an inner wall of said container and unknown biopolymer segments existing in a solution contained within said container which are to be hybridized, said container being removable from said measuring apparatus;

one or more electrodes disposed to be adjacent to said container for applying an electrical field to said container, said one or more electrodes being electrically insulated from said container; and

means for altering direction of said electric field so that wrongly hybridized segment pairs are separated; wherein

said one or more electrodes are ~~provided with protrusions~~ formed at least at spatial positions corresponding to sites whereat gather a plurality of types of biopolymer segments within said container; and wherein

said one or more electrodes are transparent electrodes.

83.(original) The apparatus of claim 82, wherein said one or more transparent electrodes are made of an ITO film.

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Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment document filed on 5/31/05 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121. In order for the amendment document to be compliant, correction of the following item(s) is required. **Only the corrected section of the non-compliant amendment document must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted.** 37 CFR 1.121(h).

THE FOLLOWING CHECKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

☑ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
- ☐ B. New paragraph(s) should not be underlined.
- ☑ C. Other Each section of an amdt. must start on a page by itself, put the remarks on a page by itself after the claims.

☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
- ☐ B. Other _____

☐ 3. Amendments to the drawings: _____

☐ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
- ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
- ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following 7 status identifiers: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New) and (Not entered).
- ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
- ☐ E. Other: _____

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf.

If the non-compliant amendment is a **PRELIMINARY AMENDMENT,** applicant is given ONE MONTH from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and **this ONE MONTH time limit is not extendable.**

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION (including a submission for an RCE),** and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a TIME PERIOD of ONE MONTH from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION,** this form may be an attachment to an Advisory Action. **The period for response to a final rejection continues to run from the date set in the final rejection**, and is not affected by the non-compliant status of the amendment.

Crystal Queen 571-272-1041

Legal Instruments Examiner (LIE) Telephone No.

Crystal Queen

Rev. 6/04

REVISED AMENDMENT PRACTICE: 37 CFR 1.121 CHANGED COMPLIANCE IS MANDATORY - Effective Date: July 30, 2003

All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: **Changes To Implement Electronic Maintenance of Official Patent Application Records** (68 *Fed. Reg.* 38611 (June 30, 2003), posted on the Office's website at: http://www.uspto.gov/web/patents/ifw/ with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. **NOTE: STRICT COMPLIANCE WITH THE REVISED 37 CFR 1.121 IS REQUIRED AS OF THE EFFECTIVE DATE (July 30, 2003).** The Office will notify applicants of amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). The non-compliant section(s) will have to be corrected and the entire corrected section(s) resubmitted within a set period.

Bold underlined italic font has been used below to highlight the major differences between the revised 37 CFR 1.121 and the voluntary revised amendment format that applicants could use since February, 2003.
Note: The amendment practice for **reissues** and **reexamination proceedings**, except for drawings, has not changed.

REVISED AMENDMENT PRACTICE

I. Begin each section of an amendment document on a separate sheet:
Each section of an amendment document (*e.g.*, Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet. Starting each separate section on a new page will facilitate the process of separately indexing and scanning each section of an amendment document for placement in an image file wrapper.

II. Two versions of amended part(s) no longer required:
37 CFR 1.121 has been revised to no longer require two versions (a clean version and a marked up version) of each replacement paragraph or section, or amended claim. Note, however, the requirements for a clean version and a marked up version for substitute specifications under 37 CFR 1.125 have been retained.

A) **Amendments to the claims:**
Each amendment document that includes a change to an existing claim, cancellation of a claim or submission of a new claim, **must include a complete listing** of all claims in the application. After each claim number in the listing, the status must be indicated in a parenthetical expression, and **the text of each pending claim** (with markings to show current changes) must be presented. The claims in the listing will replace all prior claims in the application.

(1) The current status of all of the claims in the application, including any previously canceled, not entered or withdrawn claims, must be given in a parenthetical expression following the claim number using only one of the following seven status identifiers: (original), (currently amended), (canceled), (withdrawn), (new), ***(previously presented) and (not entered).*** The text of all pending claims, ***including withdrawn claims,*** must be submitted each time any claim is amended. Canceled ***and not entered*** claims must be indicated by only the claim number and status, without presenting the text of the claims.

(2) The text of all claims being currently amended must be presented in the claim listing with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for ***deletion of five characters or fewer, double brackets may be used (e.g., [[eroor]]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change*** (e.g., ~~*number 4 as*~~ *number 14 as*). An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended," and "withdrawn" that are being amended, may include markings.

(3) The text of pending claims not being currently amended, ***including withdrawn claims,*** must be presented in the claim listing in clean version, *i.e.*, without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims.

(4) A claim being canceled must be listed in the claim listing with the status identifier "canceled", the text of the claim must not be presented. Providing an instruction to cancel is optional.

(5) Any claims added by amendment must be presented in the claim listing with the status identifier "(new)"; the text of the claim must not be underlined.

(6) All of the claims in the claim listing must be presented in ascending numerical order. Consecutive canceled, or not entered, claims may be aggregated into one statement (*e.g.*, Claims 1 – 5 (canceled)).

Example of listing of claims (use of the word "claim" before the claim number is optional):

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new): A bucket with plastic sides and bottom.

B) Amendments to the specification:

Amendments to the specification, including the abstract, must be made by presenting a replacement paragraph or section or abstract marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. Newly added paragraphs or sections, including a new abstract (instead of a replacement abstract), must not be underlined. A replacement or new abstract must be submitted on a separate sheet, 37 CFR 1.72. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per 37 CFR 1.125.

The changes in any replacement paragraph or section, or substitute specification must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for *deletion of five characters or fewer, double brackets may be used (e.g., [[eroor]]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change* (*e.g.*, ~~*number 4 as*~~ *number 14 as)*

C) Amendments to drawing figures:

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, *and may be accompanied by a marked-up copy of one or more of the figures being amended, with annotations.* Any replacement drawing sheet must *be identified in the top margin as "Replacement Sheet"* and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. *Any marked-up (annotated) copy showing changes must be labeled "Annotated Marked-up Drawings" and accompany the replacement sheet in the amendment (e.g., as an appendix).* The figure or figure number of the amended drawing(s) must **not** be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to: Elizabeth Dougherty or Gena Jones, Legal Advisors, or Joe Narcavage, Senior Special Projects Examiner, Office of Patent Legal Administration, by e-mail to patentpractice@uspto.gov or by phone at (703) 305-1616.